

## REMARKS

This amendment is in response to an Office Action dated April 30, 2003. In the Office Action, claims 1-2, 4, 7-9 and 20-23 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,987,062 to Engwer et al. (Engwer). In addition, claims 3, 5 and 6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Engwer. Claims 10-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Engwer in view of IEEE Std. 802.11 (IEEE, August 1999). Applicants respectfully traverse the rejection.

Herein, claims 2, 3 and 5 have been placed into independent form with claim 1 being cancelled without prejudice. Claims 4 and 6-9 have been revised to alter their claim dependency. Claim 20 has been revised to include limitations consistent with original claim 3.

### I. § 102(e) Rejection

Claims 1-2, 4, 7-9 and 20-23 were rejected under 35 U.S.C. § 102(e) as being anticipated by Engwer. With respect to independent claim 2, the Office Action alleges that the access point utilization value in the Short Beacon teaches a field having a traffic indicator bit. Applicants respectfully disagree because the access point utilization value is an indication of the total bit rate being handled by that AP. *See column 6, lines 27-29 of Engwer*. In contrast, the traffic indicator bit, when set, denotes a transmission after the DTIM beacon, namely the broadcast of a data frame that comprises load balancing information. Claim 2 has been amended to reflect this distinct function.

With respect to independent claim 20, Applicants have added the limitation that the DTIM beacon is configured in accordance with an IEEE 802.11 standard, similar to the limitation set forth in original claim 3.

In light of the foregoing and the dependency of claims 4, 7-9 and 21-23, Applicants respectfully request withdrawal of the outstanding §102(e) rejection.

### II. § 103(a) Rejection

Claims 3, 5 and 6 were rejected under 35 U.S.C. §103(a) as being unpatentable over Engwer while claims 10-19 were rejected under 35 U.S.C. §103(a) as being unpatentable over Engwer in view of IEEE Std. 802.11 (IEEE, August 1999). Applicants respectfully traverse the rejection because Engwer is not a valid prior art reference. The Office Action

uses Engwer as a prior art reference under 35 USC § 103(a). However, 35 USC § 103(c) excludes references which may qualify as prior art under 35 USC § 102(e), (f), and (g) from being used as a prior art reference under 35 USC § 103(a). The text of 35 USC § 103(c) recites that

“[s]ubject matter developed by another person, which qualifies as prior art under one or more of subsections (e), (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.” *See 35 USC §103(c), MPEP 706.02(I)(1).*

The subject matter of Engwer and the claimed present invention were, at the time the invention was made, owned by Nortel Networks Corporation or subject to an obligation of assignment to Nortel Networks Corporation. An assignment of the '062 patent to Nortel Networks Corporation was recorded at Reel No. 010871 and Frame No. 0324 in the U.S. Patent and Trademark Office as set forth in Exhibit 1. Furthermore, the subject application has an effective filing date of August 18, 2000 which is less than one year from the issue date of Engwer. Therefore, Engwer is not a valid prior art reference and does not obviate Applicants' claims 3, 5, 6 and 10-19 as pending. Withdrawal of the 35 USC § 103(a) rejection is respectfully requested.

CONCLUSION

In view of the amendments and remarks made above, it is respectfully submitted that all pending claims are in condition for allowance, and such action is respectfully solicited.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

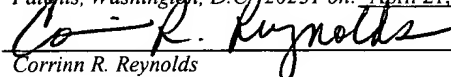
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CERTIFICATE OF MAILING

*I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on: April 21, 2003.*

  
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4/21/03  
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